

Brand Protection

Your brand is one of your businesses most valuable assets. Registering this as a trade mark is an economical way of protecting your company's brand names, logos and domain names from use by others.

Briffa can help you protect your brands and so maximise their value. Briffa can register marks for you once you decide what it is you want to protect.

We have devised the following Frequently Asked Questions for your convenience. Once you have read it you may want advice on your own specific circumstances in which case we ask you to call us on 00 44 (0)20 7288 6003 or email us at trademarks@briffa.com with your questions or a request for a detailed quotation.

In addition to our advice and quotation services, Briffa will also carry out up to three identical word mark searches in the UK for you free of charge on completion of our Trade Mark Search Request Form. Results are sent to you by email within three working days and include a quotation for making the filing for you.

Frequently Asked Questions

Q: What is a trade mark?

A: A sign distinguishing your goods and services from your competitors.

A trade mark is a sign that you apply to your goods or services to distinguish them from those of your competitors. It is a "badge of origin".

Q: What sort of sign can be a trade mark?

A: Words, pictures, smells, shapes and colours. The sign can be anything that can be represented graphically.

Words and pictures are the most common sort of trade marks. Sometimes other things can be trade marks if they can be graphically represented such as, smells (written as a chemical formula), sounds (written as music or shapes of sounds), 3-d shapes (by drawings of them) and colours (as identified by a pantone colour number).

Q: Why should I register my trade mark?

A: It will be easier and cheaper to protect than an unregistered mark and can be dealt with as property.

If your mark is unregistered, you will only be able to enforce your rights in it if you have an established reputation in the mark and someone has misrepresented their goods as yours, causing you loss.

If you have a registered mark, you can take action against them for trade mark infringement even before you have used the mark or established any reputation in it. Also, a registered mark can be dealt with as any other property and can be licensed, mortgaged, charged etc. This makes it easy to transfer it between businesses and if you don't want to use it, you can charge someone else for using it by licensing it to them for royalties. A registered trade mark adds value to your business.

Q: What's the difference between ™ and ®?

A: These notations signify unregistered and registered marks respectively. The ™ signifies an unregistered trade mark. It is notification to the public that you claim your mark as a mark of origin for your business. ® (said, R in a circle) is a notice that the mark is registered and benefits from the law relating to registered trade marks.

Q: What is the difference between a business name and a trade name?

A: A trade name gives you rights in the name.

Your business name may or may not be the name under which you trade. As long as a company name is available at Companies House you will be able to register your company in that name. Successful registration of a business name does not give you automatic trade mark rights in that name. In order to secure trade mark rights you need to make an application for a trade mark.

Q: Does trade mark law cover Internet domain names?

A: Domain names may or may not include your trade mark.

The Internet domain name registration systems and trade marks are separate. Domain names are an Internet address and using a particular domain name does not automatically confer any trade mark rights in that name. Currently domain names work on a first come, first served basis and this can create problems where more than one company has an interest in any particular name. The exception to this rule is where a domain name has been registered in 'bad faith'. Acquiring trade marks, which cover your goods and services, is one way of putting your company in a reasonable position should anyone register a domain name, which is the same as your trade mark.

Q: What types of trade marks are best?

A: Marks that do not describe your goods or services.

The best marks are ones which are in no way descriptive of your goods or state how brilliant your goods are because you will not be allowed to monopolise words that your competitors will legitimately want to use i.e. don't try to register "Great Soap" for your soap!

Q: Are there any dos or don'ts when it comes to devising a brand name?

A: Yes

We advised above under 'What types of trade marks are best' that the best marks are those which are not descriptive of your goods or services. Indeed rather than think about the qualities of your goods or services, base the name on that you could consider the characteristics of the people who will buy your goods or services and appeal to them through the name.

Q: How is it that you see the same trade mark used in respect of different classes of goods?

A: Because you register trade marks in respect of goods and services in which you do business or wish to do business.

The Trade Mark Register is divided into 45 different classes of goods and services, with the trade mark user registering for rights just in the classes of goods and services that it is providing or intending to provide.

Q: In what classes of goods or services should I register my mark?

A: Classes that describe goods and services which you are providing or which you intend to provide.

You should register for a trade mark in all goods and services in which you actually provide goods and services or which you are intending to provide goods and services within the next few years.

You cannot add classes to your original registration as your business grows and diversifies. In that event you need to make a further trade mark filing. As this is less cost effective than having selected the class in the first place, you should think ahead when you come to make your application. (Please see classification grid on inner back page giving basic class headings).

Q: What can Briffa do for me?

A: Advise you on your registrations and make them for you.

Briffa, are specialist trade mark lawyers which means we can assist and advise you, not only to acquire your marks, but also advise on effective brand protection once your marks have been successfully registered. Although our Clients can expect a personal and proactive approach from us, many of our services are available for a fixed price, which means budgeting for your brand protection is easy.

Q: How long will it take for my application to be processed by Briffa?

A: Within 7 days.

Your application will be prepared and filed within 7 days of receipt of the 'on account' official filing fees specified in the fixed fee quote you have from us. Once filed the exact time taken varies, depending on why you are filing for a trade mark and whether the Registry or any third party has any initial objections, which you have to overcome. Most applications proceed to grant within six to twelve months.

That said, the most important date is the date on which you apply for your trade mark. This is because once the registration is issued, the rights it grants to you as the owner, being from the actual date of the application.

Q: Do I really need a lawyer to file for the trade mark for me?

A: No - but it will help.

You can file your own application at the Trade Mark Registry, but you need to be aware that Trade Mark Law is complicated and you will benefit from having an expert making the filing for you. Mistakes in your filing can prevent your application progressing and can result not only in wasted fees, but also in a lost opportunity to secure your trade mark. Added to that, preparing all the necessary paper work is a time consuming task, especially for someone with no knowledge of the systems.

Q: How much will it cost to apply for a registered trade mark?

A: From £200

The cost depends on how many trade marks you wish to register and in which countries you wish to obtain a trade mark. Trade marks are territorial and you need a registration in all countries in which you seek the protection and benefit of a registered trade mark.

If you are only interested in protection in the UK, the Trade Mark Registry fees for an application in one area of business (one class) are £200. If your application spreads across different classes (there are 45 in total) you will have to pay £50 for each additional class. If you ask us to file an application on your behalf, we charge an additional £200 plus VAT for a one class application plus £50 + VAT for every additional class.

If on the other hand you would like protection in all Member States of the European Community, then it would be more cost effective to apply for a Community Trade Mark ('CTM'). The official filing fee is 975 Euros (£600 approx.) and this fee is inclusive of three classes of goods and services. There is a further official fee of 1100 Euros (£680 approx.) when your application is accepted for registration. If you ask us to file an application on your behalf, we charge £600 for the initial application.

Q: Is it possible to register a trade mark in several countries world-wide with one application?

A: Yes, but you need to meet certain conditions.

As well as applying country by country or in all member states of the European Community under the CTM as described above; you may obtain protection for a number of countries worldwide through one application. This application comes under the Madrid Protocol. There are two important conditions. Firstly, you must have a real or effective commercial establishment in, or be domiciled in, one of a list of participating countries. Secondly, you must have at least one trade mark application or registration in the country of origin in which to base the Madrid Application and the Madrid Application must be identical and not exceed the scope of the original application or registration.

This application is made through the World Intellectual Property Organisation (WIPO) via the Trade Mark Office in the country of origin. The fees for the application are in Swiss Francs and additional official fees are payable depending on the number of countries in which you seek to register your mark.

Q: What would be the best route for my business, a CTM application or an application through the Madrid Protocol?

A: It depends on your situation.

Apart from differences in costs, the best procedure for your business will depend on what protection you seek and where, as well as your current applications or registrations. We are happy to advise you on your options - please email us your questions.

Q: Apart for the official filing fees and Briffa filing fees, are there any other fees payable between filing and registration of a trade mark?

A: Additional Briffa fees are payable in certain circumstances.

A clearance search conducted prior to making your filing will reduce the risk of any individual trade mark office or third party opposing your trade mark application once made - it does however happen. Where there is a problem arising with an application after it has been filed, additional time will be spent by us putting your case for registration to the relevant authority to support your application and possibly also a hearing at the Trade Mark Office. Briffa charge on a time basis for this work and advise that you reserve an additional £1,000 where you know you are making an application that may be challenged.

Q: How many applications can I make at once through Briffa?

A: As many as you wish to.

There is no limit to the number of applications you can make, but you need to be aware that costs can quickly mount up. Generally, it is better to devise a trade mark program where you secure your most important marks first, with a view to making further filings which support your brand as your business develops. Briffa can advise you on the best routes to protection bearing in mind your budget.

Q: Is there anything I should do before applying to register the mark?

A: You should check that you are free to use the mark without infringing anyone's earlier rights. You may not be the first person to have come up with your trade mark. If you start using it without checking that you are free to do so, you could be in danger of infringing their rights. Ideally, you should always carry out a search to see if the mark is available.

Searches are particularly important if you are intending to invest a significant sum in trade mark protection. Fees for applications, which fail, are not refundable, which means that it is advisable to spend a modest amount on a search prior to filing. Briffa offer up to three free identical name searches in the UK with this service. More extensive services are available as part of our fixed fee services.

Q: How do I use my trade mark once it is registered?

A: Consistently.

Your trade marks are a badge of origin and tell your customers that they can rely on the goods or services provided under the trade mark, to be of a certain quality. It follows that you should use your mark consistently and that you should ensure that your trade mark appears not just on your goods, but on all your promotional material, stationery and invoices. The mark you register is the mark you should use and you should avoid any deviation. If printing is organised by others in your company, make sure they are aware of the importance of reproducing your mark consistently. Likewise you will need to devise a policy on trade mark use in your company so that everyone understands the importance of the trade mark and its value in communicating the quality of your goods and services.

Q: What if someone else is using or has registered the same trade mark as me?

A: It depends?

If another person or company starts using the same trade mark as you we may be able to stop them. Your rights depend on exactly what you have registered and in what classes, as against what use is being made of the trade mark by the other person. In some cases you may need to be able to show confusion between the two businesses to have a right of action. Trade Mark Law is complex and you also need to be aware that it can be unlawful to threaten someone with proceedings unreasonably. It is best to seek expert advice from lawyers such as Briffa. If you have registered your trade marks through Briffa, initial advice on how to proceed if someone starts using your mark is provided at no extra cost as part of our service.

Trade Mark Classification Grid

1. Chemicals	2. Paints	3. Cleaning Preparations and cosmetics	4. Oils	5. Pharmaceuticals
6. Metals	7. Machines	8. Hand Tools	9. Scientific and data-processing equipment and computers	10. Medical equipment
11. Lighting and heating equipment	12. Vehicles	13. Firearms	14. Jewellery	15. Musical instruments
16. Paper goods	17. Plastics	18. Leather	19. Non-metallic building materials	20. Furniture
21. Household goods	22. Ropes	23. Yarns	24. Textiles	25. Clothing
26. Lace	27. Carpets	28. Toys and playthings	29. Foodstuffs mainly of animal origin	30. Foodstuffs mainly of plant origin
31. Agricultural products	32. Beers and non-alcoholic drinks	33. Alcoholic drinks (except beer)	34. Tobacco	35. Business Services
36. Financial services	37. Construction services	38. Telecommunications services	39. Transportation services	40. Material treatment services
41. Leisure and education services	42. Scientific, computer and legal services	43. Restaurant and accommodation services	44. Medical and veterinary services	45. Personal and security services.