
factsheet

TRADE MARK REGISTRATION

For registration, a trade mark must be used or intended for use in respect of particular goods or services, and it must be capable of distinguishing those goods or services from anybody else's.

Registration must be obtained separately not only in each territory but also for each kind of product or service for which the trade mark is to be used. In most countries, the various kinds of products and services are grouped into 45 classes for the purposes of trade mark registration.

Generally speaking, the larger the number of territories and the greater the number of product and service classes, the higher the cost.

Registration can sometimes be obtained for a single country or a group of countries in a single registration, which can help to reduce the cost. For example, registering a Community Trade Mark is a more cost effective way of obtaining protection across the European Union, also since the basic cost covers registration in up to three classes.

Application can be made at any time overseas, but foreign trade mark applications can be backdated to the date of the first filing if made within six months of the latter.

Be careful as to who is named as the owner when registering a trade mark, and keep the ownership details up to date in your registration – the owner must be a legal entity such as an individual or limited company, and an unrecorded change of ownership might result in somebody being able to invalidate or revoke your registration.

The Trade Marks Registry may raise objection to an application for trade mark registration on various grounds depending on local law and practice, such as:-

1. That the mark proposed for registration is not sufficiently distinctive to function as a trade mark from the outset. This may apply to e.g. terms of art, generic descriptions, very simple short letter or number combinations such as "AI", well known place names, common surnames, and simple product illustrations.
2. In countries such as the UK and USA, that the mark appears likely to conflict with a prior registration or application for registration for the same or similar trade mark for the same or similar goods.
3. That it may deceive consumers as to the actual nature of the goods or services, or be open to objection in other ways such as being morally offensive.

These objections may possibly be overcome by argument or by filing evidence showing for example that, by significant usage in the marketplace, the mark submitted has become recognised as the company's trade mark. Additional attorney costs will arise in dealing with these objections.

In most countries, after the Trade Marks Registry has initially accepted an application for trade mark registration, a third party can still lodge objection. In some others, third party objections can be lodged at the outset. Dealing with third party objections also increases attorney costs.

In general, registration is obtained for a ten-year term, and may be renewed indefinitely, although a few countries demand some kind of proof of use on renewal, notably the USA.