

## TRADEMARK REGISTRATION PROCESS AT THE UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE

Dear Clients,

Av. Faruk Aktay, Esq. is qualified as a lawyer in Istanbul, New York and London with in-depth knowledge of Turkish, American and English law. He is also authorized before the United States Patent and Trademark Office ("USPTO").

As Aktay Law Firm, we attach importance to the protection of our clients' trademarks by registering them with the Turkish Patent and Trademark Office. However, we advise our clients who export their goods or services using their trademark in the United Kingdom ("UK") to register and protect their trademarks. In this process, we always support our clients in trademark applications in the UK and the following stages, without a lawyer/trademark attorney abroad.

### 1. What to do before trademark registration?

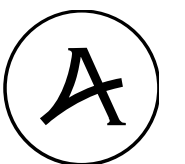
Before trademark registration, it is essential to determine whether the identical trademark already exists or is registered. This will help you to determine whether your chosen trademark is available to use and can be registered. If so, this could result in additional legal disputes.

The search is tailored to reveal potential infringement issues in the UK. If the search identifies that your proposed trademark might infringe on an existing trademark registration, you may have to stop using it and adopt a different trademark. It is, therefore, wise to check the availability of your chosen trademark at an early stage of your business plan.

### 2. How to register a trademark in the UK?

In the UK, you must apply with TM3 form to the UK Intellectual Property Office ("UK IPO"), there are a number of procedures you should think about and adhere to while registering a trademark:

- a) You should determine the unique name, sound, color, image, logo that will make your brand distinguish.
- b) You should search the UK IPO database for similar or identical trademarks.



c) When applying to register a trademark, you must decide which class of goods and services the trademark will cover. You should choose the appropriate class for your business.

### **3. What should be considered after the registration application?**

The applicant for a trademark must specify which classes the trademark will be used in when filing the application. With each additional class specified, registration's scope of protection expands. Once the application has been submitted to the UK IPO, the applicant will be granted an application number and date. Since it will be used as the registration date once the trademark is registered, the application date is important.

Following that, the UK IPO will make the decision of the application public via an Examination Report. If a trademark does not meet the UK IPO's criteria for uniqueness or merely specifies the goods and services that will be offered under the trademark, it will not be accepted for registration. If the UK IPO does not raise any concerns or the concerns are dismissed, the trademark will be advertised in the journal. Objections from third parties are allowed after the application has been published. In the absence of any opposition filings the trademark will remain registered.

### **4. What objections can be made against the trademark by third parties?**

There may be a number of circumstances that give rise to objections against the trademark during registration in the UK when the UK IPO conducts the examination procedure. These are a few instances where an objection is frequently raised:

- If the trademark has no distinguishing features.
- If the trademark just serves as a description of the features of the goods and services
- If the trademark is against the principles of morality or public policy.
- If the trademark is deceptive.
- If the trademark has been prohibited by any rule of law.
- Whether any official marks or symbols are included in the trademark, such as the royal coat of arms, the flag of the United Kingdom, the royal flags, or national emblems of Paris Convention nations.
- If the trademark application was submitted dishonestly or with false intent.
- If the trademark is offensive.

The applicant is granted between two months and five years to change the aspect of the trademark that has been objected to, depending on the type of concern with the trademark that has been raised.

The UK IPO's rulings may also be appealed in court, including before the High Court of England and Wales, the High Court of Northern Ireland, and the Court of Sessions of Scotland.



## **5. What are the benefits of trademark registration?**

Having a trademark registered in the UK has a number of benefits:

- a) It is essential to register your trademark in the UK as soon as possible since, like the trademark system in the European Union, the UK operates on a first-to-file basis. A first-to-file system, in essence, gives the first person to file for a given trademark exclusive rights to use that mark, regardless of whether they used it first.
- b) Trademarks are territorial, therefore if you register a trademark in another nation, it won't be protected in the UK.
- c) If your trademark application is approved, it will be made public in a central registry, putting third parties on notice and maybe discouraging them from using your mark or one that is similar.
- d) The ability to license your mark for a profit or mortgage it for a loan makes a registered trademark valuable.

A registered trademark also gives you the ability to defend yourself against "cybersquatters" which is another benefit. There are those who attempt to resell your domain name to you for a substantial amount of money after purchasing one that is linked with your brand name or company name. If you have a registered trademark, you can simply defend yourself from anyone who uses a domain name that is confusingly close to or the exact same as your trademark in the same industry or for fraudulent purposes.

## **6. How can trademark protection be renewed?**

The registration is valid for ten years and may be extended by paying renewal costs for an additional ten years. The start date of registration is the application date. As long as a trademark is renewed, it can be kept in use permanently.

The owner has six months after the renewal date to file for a late renewal with the payment of an additional cost if they do not submit their renewal application before the anniversary date. By the end of these six months, if a renewal application for the trademark has not been submitted, it will be withdrawn from the register and expire.

By registering your trademark, you can avoid expensive legal disputes and enforcement actions and instead invest your money in developing both your brand and your company. Trademark rights are also an asset that can appreciate significantly in value. Registering a trademark is a simple, effective and cost-efficient way to protect your company and help your business grow, prosper and succeed.

