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# Everything you need to know about applying for a trade mark

This guide can be downloaded from our website:

<http://www.bipcnewcastle.co.uk/your-idea/intellectual-property> and a timeline showing the stages of the application process is also available.

Your application for a UK trade mark is made to the **UK Intellectual Property Office (IPO)**,

<https://www.gov.uk/government/organisations/intellectual-property-office>.

From January 2021 the UK is no longer part of the EU trade mark system. All existing EU trade marks were given comparable UK marks—the number allocated to the comparable UK mark is the last 8 digits of the EU trade mark prefixed with **UK009**, and this mark is now completely separate from their EU protection. Full details on changes found here: <https://www.gov.uk/guidance/eu-trade-mark-protection-and-comparable-uk-trade-marks>.

## Application checklist

1. Make sure you understand what can or cannot be trademarked.  
See page 1 of this guide.
2. Determine which classes of goods/services you need to register in. Make sure you have the right classes (if necessary contact the IPO to clarify).  
See page 2 of this guide.
3. Start to draft ideas for your trade mark. If it is a logo do not go beyond sketches at this point. You should not waste time producing a finished design, or, worse, commissioning someone else to do so, until you have thoroughly searched for existing trade marks.
4. Carry out a trade mark search. The databases you should use will be determined by the countries you wish to seek protection in. See page 6 of this guide. You would be advised to employ a trade mark attorney if you wish to apply beyond the UK. See pages 6 to 13 of this guide for information on searching databases.
5. Make sure you are familiar with the application process  
See pages 4 to 5 of this guide and the separate timeline.
6. File your online trade mark application.
7. Await the search report. Respond to any objections raised by the examiner.
8. Wait for your application to pass the two month opposition period.

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# What is a trade mark?

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**A trade mark is a sign which distinguishes your goods or services from those of your competitors.**

The best trade marks often consist of invented words (e.g. Adidas), common words used in an unrelated context (e.g. Orange or Sky) and logos that allude to a particular quality, but only indirectly (e.g. Apple's logo refers to the apple that fell on Newton's head and therefore obliquely to inspiration and innovation). Read the sections under **Introduction to trade marks** and **Apply for a trade mark** on the main trade marks page of the IPO website, <https://www.gov.uk/topic/intellectual-property/trade-marks>, after you have read this guide.

A trade mark may be infringing another if the mark is the same/similar and the goods/services it is used in conjunction with are the same/similar.

## Exceptions

A trade mark must be distinctive. A trade mark **cannot** be registered if it:

- Solely describes your goods or services or any characteristics of them, e.g. Quality Furniture.
- Has become customary in your trade (although a descriptive or customary term can be made distinctive by the addition of a name).
- Is a protected emblem (includes flags, state emblems, official signs and abbreviations and names of international inter-governmental organizations), e.g. the Olympic rings are protected and cannot be included in a trade mark.
- Is offensive, deceptive or promotes something which is illegal.

The most common mistake is trying to register a purely descriptive trade mark that has nothing to make it distinctive. Make sure you avoid this!

For further guidance see <https://www.gov.uk/guidance/unacceptable-trade-marks>

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# Trade mark classification

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## What is classification?

When you apply for a trade mark you must specify which classes of goods/services you wish to use your mark with. The **Nice** classification scheme is used and is an international standard; these classes will apply no matter which country you apply to or which database you search.

If you find the same/similar marks in different classes and there is no likelihood that the goods/services provided by the owner of this mark will overlap with yours it may still be possible to have your mark registered. But your mark will have to be very different from an existing one in the same classes where the owner trades in the same/similar goods/services as you.

## What online resources are available?

For an overview of the classification scheme go to the UK IPO website: <https://www.gov.uk/guidance/how-to-classify-trade-marks>

Click the **General indication of goods and services** link to get a list of all the classes with a summary of the main goods/services in each class. Classes 1-34 relate to goods and 35-45 to services. This is a link to the World Intellectual Property Organization's full listing of the Nice classification, and can also be found at: <http://www.wipo.int/classifications/nice/en/> (Click the **Access the Nice Classification** link).

There is a numerical list, an alphabetical list and a keyword search facility. The alphabetical list is useful for browsing, however the keyword search is quite basic.

The **search UK trade mark classes** link will take you to a new IPO classification search tool. Until January 2021 a link to a much better search tool called **TM Class** was provided on this page, but sadly that has now been removed. We would still recommend using TM Class to search for classes by keyword and you'll find it here: <http://euipo.europa.eu/ec2>

Using the basic search facility you can only search for results that contain ANY of the search terms entered. Click the **Advanced Criteria** button to search using either:

- **Word prefix/suffix:** will only retrieve results containing all words that begin or end with the terms entered (similar to wildcard searching)
- **Full phrase:** will retrieve results containing the exact phrase only (in this case wildcard searching does not apply)

E.g. search for the words *social network* using Word prefix and you will discover that online social networking services fall in class 45; do the same search using Full phrase and you get no results (in this case you only get results when you enter *social networking*).

## Listing Your Goods/Services

In addition to selecting which classes you wish to register in you must also list all the goods/services you are providing or intend to provide. Although in some circumstances amendments may be possible you should consider carefully what you are intending to do or are likely to do in the future—try to think 3-5 years ahead!

Within each class description you can add as many goods/services as necessary, but should not list items you are unlikely to provide. Your competitors can apply to have these removed if you have not begun to provide them within a time period (around 5 years from application).

Once your mark is registered you can later apply to add more classes by making a new application in the new classes, which of course means paying the full application fee again. If you have wrongly classified the goods/services described on your application the examiner may give you the opportunity to add extra classes before it is examined, but there are limits to what changes you can make. You can avoid this by contacting the IPO Classification Team, <https://www.gov.uk/guidance/how-to-classify-trade-marks> (scroll to the very bottom of the page for the email address), before you apply, in order to confirm you have selected the right classes.

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# Application process

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## File your application

After you have carried out your searches and are satisfied that it is worthwhile applying you can file your application very quickly online: <https://www.gov.uk/how-to-register-a-trade-mark/apply>. If your trade mark is a logo you will need to prepare a good quality digital copy to upload during the application process.

For UK protection you will pay £170 for the first class and £50 for each additional class. You have two main choices:

- You can opt to pay the whole application fee up front **or**
- Use the **Right Start** application option and pay half the fees up front and the other half after you have received the examination report. However, in this case you will pay £200 in total for the first class (pay £100 plus £25 for each additional class up front, and then the same again if you decide to continue with the application after receiving the examination report).

Alternatively, you can still post your application on a paper form, but you will pay £200 for the first class in this case.

You can apply for a series of marks where there are slight variations on the mark. Limited to a maximum of 6, the first two are included in the application fee and from 3-6 at £50 each. There are strict criteria for what counts as a series. Read the guidance on this page:

<https://www.gov.uk/guidance/trade-mark-series-applications>

or for more detail go to the following page, select **Show all sections** and search the page (Ctrl+F) for *series*:

<https://www.gov.uk/guidance/trade-marks-manual/the-examination-guide>

When specifying the classes you wish to register in you are prompted to provide a description of your good/services in each class. You can either select from an approved list (which can be confusing) or upload your own description. If you wish to use your own description you would be advised to prepare this in advance – just make sure you have checked you are using the right classes for the things you wish to include.

## Respond to the examiner's report

If there are any problems with your application, e.g. the examiner is unhappy with the wording of your goods/services description, you will have the opportunity to respond to this. You will receive an **examination report** within 60 working days and have up to two months to respond to it. If you used the Right Start service you must pay the other half of the fees within 14 days of receiving the report to continue with the application. The IPO will not refuse your mark if there are earlier conflicting marks, but the owners of the UK marks will be notified and the onus is on them to object.

## Wait for the opposition period to elapse

Before your mark can be registered it must first pass the opposition period. This lasts 2-3 months and during this time your application details are advertised in the Trade Marks Journal which can be found on the IPO website, <https://www.gov.uk/check-trade-marks-journal>.

If no one objects within 2 months your mark can be passed for registration. However, if the owner of a conflicting mark wishes to object, but is unable to present their case within the 2 month time limit, they can apply to extend this to 3 months.

## Extending protection to EU and other countries

An EU trade mark will give you protection in all EU countries. It is cost effective, but a valid objection to your application in just one country could mean the entire application is rejected. See <https://euipo.europa.eu/ohimportal/en/apply-now> for application details. From January 2021 the UK is no longer included in the EU trade mark.

If you wish to apply in other countries you can use an international system called the Madrid System. This is based on two treaties, the Madrid Agreement and the Madrid Protocol (states may be party to either one or both of the treaties).

The UK is only a member of the Madrid Protocol, so your application must exclude states which are signatories of the Agreement alone. See: <http://www.wipo.int/madrid/en/members> for lists of members.

If you apply within 6 months of your UK application you can claim priority, which means you will have precedence over any applications which were filed after your UK application in those countries you are applying to. See <https://www.wipo.int/madrid/en/> for application details. It is usually advisable to use a patent or trade mark attorney when applying outside the UK.

We can also provide a timeline summarising the trade mark application process, which can be downloaded from our website.

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## Searching for existing trade marks

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The purpose of your search is to identify any existing trade marks that are the same/similar to yours for the same/similar goods/services.

In this guide we have focussed solely on reliable databases that are free to search. The databases you need to search will depend on the intended scope of your trade mark:

- For **UK protection only** use the UK IPO site (see page 7) or TMview (see page 10) for searching logos.
- For **EU protection** use the EU IPO search (see page 9) and also TMview for national trade marks of individual European states.
- For **international protection** use Madrid Monitor (see page 11) for international trade marks applied for under the Madrid System. Also search for national trade marks for the countries you intend to include—use TMview or Global Brand Database (see page 12) for countries available on those databases; try the websites of the national intellectual property offices of those countries not included.

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## Searching: UK only

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### IPO (UK trade marks)

This database contains UK trade marks and international trade marks that have extended into the UK. To access this database choose the **keyword, phrase or image** link on the following page:

<https://www.gov.uk/search-for-trademark>

### Wordmark search

The **Search by** option will show as **Word** by default. The **Search type** is set to **Similar** by default. Click the drop-down box and you will see other options. If you use the **Similar** option you are relying on the software to interpret all possible similar words and this might not be satisfactory. You need to stay in control of your search and you do this by using the **Contains String** option. In this case the search will pick up the words you enter wherever they occur even within a word. The drawback is you can only string search one word at a time as the database considers everything you enter in the box as the string to search.

You need to look at the words you are using and consider all possible similarities: similar spellings, phonetically similar words. Anything that could be confused with an existing mark could be opposed. Look for exact matches in all classes, then look for very similar marks, then focus on distinctive elements of the mark in the relevant classes (you can restrict your search to specific classes by clicking in the **Select class(es)** box and choosing classes from the list that appears).

Punctuation marks such as apostrophes, hyphens, full stops should be ignored when searching (the search engine will ignore them anyway, but inserting them may break up a word and affect your results). The only ones that can be searched are pound (£), euro (€), dollar (\$) and 'commercial at' (@ - if you find the English word for this symbol too drab simply insert your own language's word for it here).

**ALL words/ANY words** radio buttons toggle between AND and OR functions.

## Image search

Visual trade marks are commonly known as logos, but you will see them referred to as **figurative marks** or **devices** in intellectual property literature. Another classification scheme, the **Vienna Classification**, is used to describe the constituent elements of a logo.

Set **Search by** to **Image**. You should first select a Category, then Division, then Section. E.g. for the Apple logo the Vienna classification would be: 05 Plants; 05.07 Grains, Seeds, Fruit; 05.07.13 Apples. Make a note of the class numbers: you will need to use them when searching other databases. For logos with constituent elements in more than one class click the **Add another class?** button and choose the **Yes, and** option (the **Yes, or** option will too many results).

Do not confuse this class with the Nice Classification: the Vienna class refers to the actual pictorial elements in the logo and **not** the goods/services you provide. Note that you cannot search in classes 26 (Geometrical Figures) and 27 (Forms of Writing) on the UK IPO site. However, you can search for UK trade marks using these Vienna classes using **TMview** (see page 10); select **GB** from the **Territories** drop-down list of the **Advanced search** on that database.

A full listing of the Vienna Classification can be found at:

<http://www.wipo.int/classifications/vienna/en/>

Click the **Access the Vienna Classification** link.

Only 1000 results can be viewed, so if you get too many you may need to break down your search into chunks, limiting by Nice class and possibly by date range. Again **TMview** (see page 10) is often a better alternative when searching for image marks as it doesn't restrict the number of results you can view and has a Gallery Mode feature.

## Combined Wordmark and Image Search

You can also combine searches using the option **Word and Image**. However, even if you intend to apply for a word and logo in a single trade mark you should still search separately for word and logo elements. This combined search may be useful in some cases, for example where your logo consists of a cartoon character in the shape of a letter. Searching for a single letter by itself would be pointless, but when combined with the image search it should quickly reveal anything too close to your intended mark.

## Interpreting Your Results

After you click the green **Search** button at the bottom of the page you will get a list of results providing mark text, image and Nice classes. To see full details for a mark click on the blue trade mark number (begins with UK). This will show full details of the mark, such as current status and a full list of all the goods/services the owner provides within the classes they are registered in. This could be very useful as a potentially conflicting mark even within the same class may be restricted to goods/services that do not overlap with your own (if yours are similarly restricted and different). You may wish to seek the advice of a patent or trade mark attorney to interpret the results.

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## Searching: European marks

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### EU IPO (EU trade marks)

<https://euipo.europa.eu/eSearch/>

The EU IPO is responsible for both EU trade marks and registered designs. Now the UK is no longer included in the EU trade mark this database will be less important unless you wish to protect your mark in EU countries as well. Click the **Advanced search** link.

There are a number of tabs in the centre of the page; the first, **Trade**

**marks**, should be active. Use the **Trade mark name** field to begin your search. You can search for words using the following options from the drop-down list: **contains, is, starts with and ends with**. You can also use wildcards (\*) and jokers (?), placing them anywhere within the search string. It's also possible to use Boolean operators: click **Trade mark name** in the **Add search criteria from below** list to add a new search box with a drop-down list that can be changed to **and, or** or **not**. Use quotation marks for phrase searching.

To search for logos it is easiest if you already know the correct Vienna classes. As these are given in the drop-down menus on the UK IPO search screen you should search there first and make a note of the relevant classes.

Click **Vienna Classification** in the left hand list and a search box will be added. You can type the class number in the box and a suggestions list will pop up (you can also type keywords in the box, but this can be confusing). Input a complete class in the format: **nn.nn.nn** or use wildcards, e.g **nn.nn\***. To search for marks that have more than one class click **Vienna Classification** in the left had list again (the drop-down box should show the word **and**), then choose the next class. As an alternative to using these Vienna classes it is now possible to upload an image to search (see page 13 for further details).

The results list shows trade mark, image and some details in a well-presented list. Click on the trade mark name for further useful details such as a timeline of the application and access to correspondence filed.

## **TMview (EU and European national trade marks)**

<https://tmdn.org/tmview/welcome>

This database covers EU trade marks as well as national trade marks from all EU countries and international marks under the Madrid System. Its coverage seems to be expanding as it now also includes data for Russian, US and Japanese marks. Each country supplies its own data, so coverage is not fully consistent. For UK trade marks you can search all Vienna classes, including class 26 and 27 (see page 8).

Click the **Advanced search** button. If you want to search for marks valid in certain countries use the **Territories** option rather than **Offices**. Type words in the top search box. You can use wildcards (\*), before as well as after the word. You can also use jokers (?). If you enter more than one word the search will be for all marks containing these words separately. Choose **Is** from the drop-down list next to the top search box to search for an exact phrase. The **Fuzzy search** option will search for similar spellings.

To get back from the results list to modify the search use the pencil icon at the top right of the screen. When you click on a trade mark in the results list its full details are shown and you can return to the results list by clicking the **Back** button in the top middle of the screen.

Add Vienna classes in the same way as for the EU IPO search (see page 9-10). You can also use wildcards with Vienna classes, e.g. **nn.nn.\***. In the results list **Gallery mode** (selected by the icons at top right, just above the results list) lets you see just the logos in a grid – very useful in quickly scanning for similar marks. If you add more than one class your search will find marks that have one class **or** the other. To search for marks that contain more than one class together just run the search for one class and then select the other Vienna class (if the combination exists) in the filters on the left of the results list. As with the EU IPO search you can upload an image file to search for similar logos (see page 13) - camera icon at right of the top search box.

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## Searching: international marks

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### Madrid Monitor (international trade marks)

<http://www.wipo.int/madrid/monitor>

Covers international marks applied for using the Madrid System. Use **Simple search** for word searching, but **Advanced search** if you wish to restrict by Nice class. By default *any* words added will show in the results. Use **+** before word to include, **-** before word to exclude. Use quotation

marks to search for a phrase. You can use **Boolean searching** (AND, OR, NOT - must be in upper case) and proximity searching: put the words in inverted commas and add ~n (where n is an integer) at the end - shows results where the second word occurs within n words of the first. Wildcards (\*) can be used before, after or within a word string, and also jokers (?).

To use Vienna classification enter class numbers in the form **nn.nn.nn** - suggestions will appear as you start to type a number or click the arrow next to the box to use a look-up table. To search for marks with more than one Vienna class, search for the first class then use the **Filters** at the left of the results list to limit by another class. You can also limit searching (in the main **Advanced Search** page) by Nice classification (for single digit classes enter leading zero to get a pop-up description) and by keywords in the goods/services descriptions.

When viewing the results screen use the pencil icon at right of the search bar to take you back to the search screen. Click on a mark to view details (there is a **back** button to return you to the results list). The status history of the mark is shown—once you have the mark number you can also use **Realtime search** from home page to get the most up to date status. A nice feature is the ability to download a results list or individual mark details. There is also an **Image search** option to allow you to upload a logo image (see page 13). The Image search option is in the menu at the left of the home page.

## Global Brand Database

<https://www3.wipo.int/branddb/en/>

A growing resource for searching international brands from more than 60 countries, including EU and Madrid marks, and includes some individual countries not found on TMview.

The option to upload an image can be found in the **Filter By** options at the right of the home screen (see page 13).

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## Searching: image searching

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All these databases with the exception of the UK IPO now allow you to upload an image to carry out a search for a logo. This sometimes works better as you don't need to identify **Vienna** classes. However, the results may also introduce many irrelevant marks, or miss relevant ones, so you shouldn't rely totally on this type of search—always carry out a separate search using Vienna classes as well.

### **EU IPO** and **TMview**:

These both use a very similar search engine. Not all offices on the TMview database support this search. There is a grid view option which allows you to view 100 images simultaneously for the EUIPO search, and 30 for TMview. The TMview search has a slow response. Both seem to work well, but the EUIPO search produces the best results. Even if you only intend to register in the UK you can carry out the image search on TMview (see page 10): just select **GB** from the Territories drop-down list of the **Advanced search** on that database.

### **Madrid Monitor** and **Global Brand Database**:

These both use a very similar search engine. Both have a grid view option which allows you to view 100 images simultaneously. There is a choice of 4 different search strategies to employ: Concept, Shape, Colour and Composite, and you can also specify whether the logo is Verbal/Non-verbal/Combined. Concept and Shape options seem to work best; the Combined option may improve the results found for a complex logo with text and images.

Bold, simple images are recognized better and produce good results. More complex combinations of text and images or where the image is not clear produce more random results.

# Glossary

**Device:** In trade mark terminology this is used to describe a visual trade mark which may or may not contain words (often referred to logos).

**EU trade mark:** The EU trade mark is a single trade mark that covers all EU countries.

**Figurative Mark:** Another term for a visual trade mark which may or may not contain words (often referred to logos).

**Joker(?):** A symbol used in a search term to replace a single character.

**Madrid System:** The Madrid System is a convenient and cost-effective way to register and manage trade marks worldwide, by filing a single application and paying one set of fees.

**Nice Classification:** International standard for classifying goods and services in trade mark applications.

**Priority:** A right recognised by the great majority of countries around the world that allows a trade mark applicant a six month period from the date of first filing to file in any other country and for the application to be examined as if it was filed on the date of the first application.

**Trade mark:** a sign which distinguishes your goods or services from those of your competitors.

**Vienna Classification:** International standard for classifying the figurative elements of trade marks into categories, divisions and sections, on the basis of their shape.

**Wildcard (\*):** A symbol used in a search term to replace zero or more characters.

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