

# Mark-IT

The Newsletter of the Trade Marks Registry

No 1: December 09

**Hot stuff  
in the  
East  
Midlands**

**Registering your  
trade mark is now  
easier than ever**

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# Registering your trade mark has just become easier (and cheaper)

**IN THE May edition of Mark-It we focused on the effect that the economic downturn was having on trade mark registration.**

The number of companies and individuals registering trade marks was falling. We pointed out that companies would benefit by continuing to build and protect a valuable IP portfolio, and that by doing so they could ensure that they were in the strongest position to make the most of the recovery when it came.

We recognised though that there was probably more we could do to offer real help with registration. We announced that we were running a public consultation to explore how we could improve our services and the fees we charged for them,

to encourage more businesses to register their trade marks.

Almost six months on and we have introduced a new service – the RightStart service – that we hope will help small businesses and unrepresented applicants in particular to more easily protect their marks.

We also introduced a reduction of £30 on our standard fee for all applications that are filed electronically.

We are in early days with both, but they appear to be popular measures that are filling a genuine business need. Further details can be found in this issue.

We have also done a lot more to publicise the benefits that come from registering trade marks, and this edition of Mark-It describes that marketing activity.

On a more general level we held, in conjunction with the British Brands Group and the CBI, a conference on the value that brands bring to both companies and the UK economy.

The conference was a rare occasion on which policy makers, brand owners, their attorneys and marketing advisers, and academics have all come together to consider what could be done to make the UK a better place in which to develop and nurture brands.

There will be more on the outcomes from that conference in the next edition.

So the theme running through much of our activity over the last months is: 'What can we do to help business?'

If you have any further thoughts please let us know.

**ANDREW LAYTON, Director of Trade Marks & Designs Intellectual Property Office**

# Guiding lines from The Times

**THE TIMES published a very useful Guide on 20 October on 'How to protect your intellectual property'.**

This article highlighted the value of a company's intellectual assets and the importance of protecting it.

Intellectual assets are central to many businesses and relevant to all, even if it is only a matter of the corporate logo.

Mark Friend, head of media and entertainment in the technical services division of CapGemini, pointed out that you need to protect your intellectual property in order to be able to exploit it.

A recent survey quoted by the Financial Times in July this year found that a third of businesses were actively seeking ways of exploiting their intellectual assets further by considering licensing and joint ventures in order to generate additional cash flow.

**If you find that your business name belongs to someone else, you have to stop using it immediately.**

This would allow companies to be more flexible in order to adapt to changing marketing conditions and to minimise their risks.

The Times Guide advocated conducting a knowledge audit or IP 'Healthcheck' – you can find out all about this on our website at [www.ipo.gov.uk](http://www.ipo.gov.uk). Our Healthcheck tool is free to use and should take you no more than 15 – 20 minutes to complete.

You will then receive a tailored confidential report on your IP provisions including a list of recommended action points to help you decide how to protect and exploit your IP rights.

We will also provide practical guidance on how to put these

recommendations into practice and give you links to other websites and resources which will help you further.

This will be very useful in helping you to decide on the level of protection you need. When registering your trade mark, you need to decide whether you are only planning to operate your business within the UK.

If you intend to expand into Europe for instance, you may consider registering a Community Trade Mark with the Office for Harmonisation in the Internal Market (the OHIM) – more details on their website at [www.oami.europa.eu](http://www.oami.europa.eu).

Do not delay in taking action however – we have seen countless examples of businesses launching new products or services only to find out that the name belongs to someone else and they then have to stop using it immediately.

Our case study feature, starting on page 7 of this edition, will give examples of some real horror stories!



How safe is your intellectual property? Go to: [www.ipo.gov.uk](http://www.ipo.gov.uk) to find out about our **INTELLECTUAL PROPERTY HEALTHCHECK**

# East Midlands tour gives the area a trade mark boost

**DUE TO the economic downturn we found that many companies were choosing not to protect their trade marks – applications in 2008 had been 12% down on 2007 figures.**

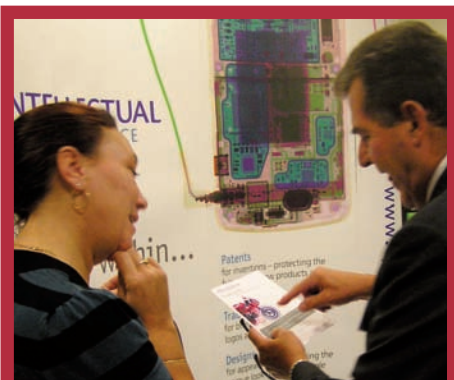
With this in mind, we decided to launch a more targeted programme directly promoting trade mark registration.

We selected the East Midlands region for our pilot programme – this included towns such as Nottingham, Lincoln, Derby and Northampton.

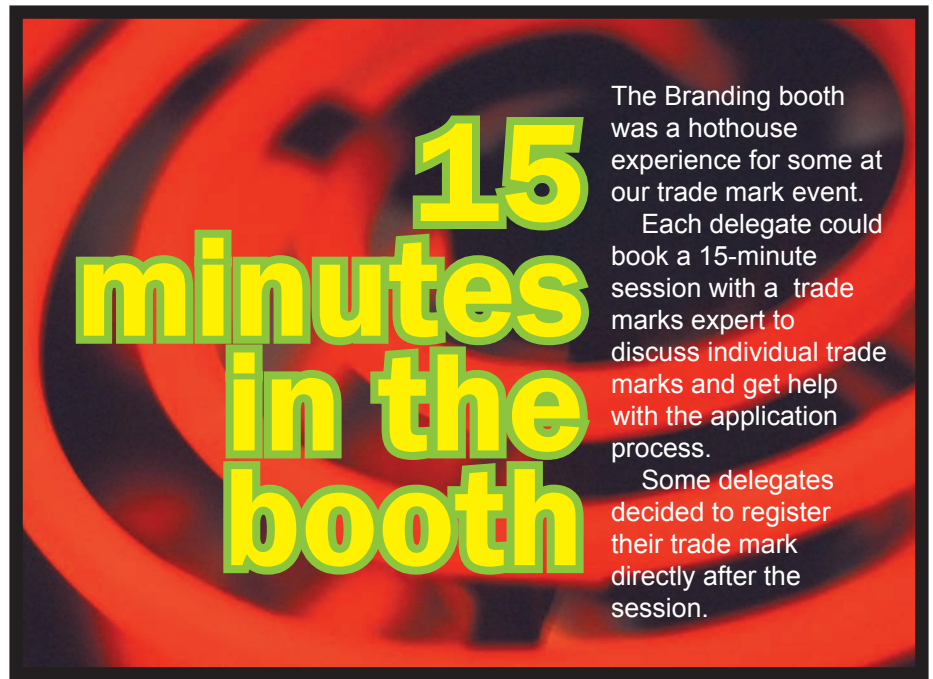
This area had seen a 20% drop in trade mark applications filed in 2008 compared to 2007 so we knew that this was going to be a challenge for us!

We worked closely with regional partners to hold a series of events in the area from May to the end of August and also published many promotional articles in regional publications.

Our programme culminated in a flagship event at the Thistle Hotel, East Midlands Airport on 26 August 2009. We invited along relevant regional support agencies like Business Link, UKTI and Prospect IP who provided overviews of their role in promoting intellectual property and were at hand all day to answer queries at their stands.



**FULL MARKS:** Experts were happy to answer queries about branding.



The Branding booth was a hothouse experience for some at our trade mark event.

Each delegate could book a 15-minute session with a trade marks expert to discuss individual trade marks and get help with the application process.

Some delegates decided to register their trade mark directly after the session.

**Some delegates found it hard to believe that an application cost just £200.**

This event attracted around 140 attendees who were mostly private applicants. Attendees were given the opportunity throughout the day to book 15 minute sessions at a Trade Mark 'Branding Booth' to discuss their individual marks or to obtain help through the application process.

Delegates commented on the usefulness of this service and welcomed the chance to have free in-depth advice from trade mark experts on the probability of success of their mark and how to navigate their way through the application process.

Terry from the East Midlands commented: 'Yes, we did book a slot (in the Branding Booth) and it was incredibly helpful. So much so that we have now registered our trade mark directly as a result. We are now waiting for approval.'

Indeed, Terry was not alone in applying to register her brand straight after our advice sessions: 20 other delegates said that this event had inspired them to file and we have already received 8 of those applications, some covering quite a few classes.

Some delegates were amazed at how reasonable our application costs were and found it hard to believe that an application cost only £200 with £50 for each additional class. From 1 October, e-filed applications also qualify for a further discount of £30 from that price! More about that on Page 6.

**We will be continuing our programme of regional events next year. In January/February we will be in the North West of England.**

## Science Museum event

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**TEA-RADE MARKS:** Wallace & Gromit were among the presenters at the Science Museum event. They were there as the prime movers in the Intellectual Property Office's Cracking Ideas scheme, which encourages innovation in schools.

# What's in a name?

**AT THE Science Museum on both 16 July 2009 and 27 August 2009, Wallace & Gromit were joined by IPO staff who delivered two presentations to SMEs and individuals who were interested in protecting their brands**

The first presentation explained the benefits of trade mark registration and, by the use of case studies, demonstrated what disastrous pitfalls are potentially around the corner if a trade mark is not registered.

The second presentation outlined the examination process and provided a 'walk through' of how to complete the trade mark application form. It also explained what assistance is available to customers before and after submitting an application.

The presentations were well received and early feedback was positive. Bart from West London commented: '(It) was a pleasure attending "What's your Name Worth" seminar, very helpful indeed.

'Thank you for breaking down all the information and making it so easy to understand.'

Judging by the many questions, both during and after the presentations, the message was definitely of interest to all who attended.

Attendees seemed to appreciate the major benefits of registration and realised that the application process itself can be a simple and cost effective way of protecting their brand.

The case studies were particularly effective and will be expanded for future events.

The event also highlighted for us the areas we need to focus on for additional guidance to help applicants through the process.

We will now keep in close contact with the attendees and keep a keen eye on whether the presentations resulted in an increased number of TM applications!

Not everyone could attend this event, so please contact us if you would like to receive a copy of the slides.

## TELL US WHAT YOU THINK

Email: [mark-it@ipo.gov.uk](mailto:mark-it@ipo.gov.uk)

## Online trade mark surgery is a hit with customers

**ON 5 August 2009 we held an on-line advice day which enabled customers to receive fast responses to their questions from a team of trade mark experts.**

We received a total of 15 questions on the day. These covered a wide range of topics including: expired trade marks, series marks, colour of logos, Community Trade Marks etc.

We will be looking at providing this Surgery as a regular monthly service. We would be interested in your views on this – please email: [mark-it@ipo.gov.uk](mailto:mark-it@ipo.gov.uk).

### Your comments so far

'This has come at just the right time for me – a good initiative.'

'I would like to take this opportunity in thanking your team for the time and effort. I found the surgery very useful and beneficial and am sure that all those who choose the service would be of the same opinion.'

'It was very helpful. Thank you again and congratulations for such an interesting initiative.'

Go to our Trade Mark Frequently Asked Questions page to view all questions and answers:  
<http://www.ipo.gov.uk/types/tm/t-about/t-faq.htm>.

# Branding in a modern economy

**BRAND BONUS:** David Lammy (right) told the conference that brands contributed more than £15 billion to the UK economy.



## Minister praises UK's building of internationally respected brands

**WE HOSTED, in partnership with the British Brands Group and the CBI, a high profile branding conference on 11 November.**

This event placed the spotlight on branding to highlight its:

- economic force in the UK
- current place in Government policy
- potential to leverage greater value, wealth and jobs.

This important initiative was led by the Minister of State for Intellectual Property, the Rt Hon David Lammy MP who praised the UK's strength in building internationally respected brands that contribute more than £15 billion to the country's economy each year and have created over 1 million jobs.

David Lammy said: 'Brands are everywhere: from the adverts we watch on television to the cereal we pick off the shelf at the supermarket, they are a recognisable part of our everyday lives.'

Branding is a source of global competitiveness and a significant generator of wealth.

'Yet just as importantly they are the lynchpin of business and an essential contributor to our economy. Businesses understand their relevance and are willing to invest heavily in them as a result.'

'I want to take this opportunity to bring together as many organisations as possible and listen to the issues that matter to them. Their input will help us in Government to work better with them and develop the next steps that will harness the potential of brands in the UK.'

Branding is a very strong force in both consumer and business-to-business markets and is relevant to products, services and corporations. Brands matter, particularly in these testing times where sources of value need to be realised and the UK is seeking to position itself competitively for future success.

John Noble, British Brands Group commented on the conference: 'Branding is crucial to a modern economy, being a source of global competitiveness and a significant generator of wealth, while being responsive to the needs of society.'

'This conference is an important first step in determining the importance of branding to the UK and our ability to compete effectively on the world stage.'

Following the event, a report highlighting the key findings and discussion from the presentations and comprehensive workshops, will be presented to David Lammy.

The report will aim to outline practical next steps to further develop the UK as a leader in brand building, and continue to provide effective support for innovative businesses.



# Cheaper, easier trade marks help protect business assets

**FROM 1 October 2009 we introduced new changes to our fees and services with the aim of simplifying the trade mark registration process for businesses and also to make the process more cost effective with our new 15% discount for E-filing.**

We held a Launch event at the Science Museum on 1 October to explain the effect of these changes and to answer delegates' questions.

Our new initiatives include:  
**Right Start – an on-line trade mark application service.**

For an initial payment of £100 (half the standard application fee), customers will now be able to see their examination report before deciding to proceed with the application and paying the remainder of the fees due.

Trade mark examiners will be on hand to offer assistance throughout this process.

The initiatives will make it cheaper and easier for businesses to register trade marks.

Our new Right Start service is proving very popular with our customers. We received 462 applications via Right Start in October which is 20% of our e-filed applications and 14% of our applications in total.

**Reduced fees for Electronic Filing** – a 15% (£30) reduction in fees for e-filed trade marks where the full fee is paid at the time of filing.

There has been a marked increase in our e-filing percentage since we introduced this discount. We have received a monthly average of 64.8% of our applications electronically prior to October this year.

In October, the first month we applied this discount, e-filing accounted for 80% of our application total.

David Lammy, Minister of State for Intellectual Property, commented: 'The new Right Start service and E-filing discounts for trade marks adds to the increasing level of support the IPO is giving businesses wishing to manage their intellectual property.'

'Trade marks enable businesses to protect and profit from the brand identity they have carefully crafted. By taking the step of registering trade marks, businesses are making a small investment in their brand that can have larger positive commercial results in the future.'

'The initiatives will make it cheaper and easier for businesses to register trade marks and to obtain these benefits.'

We'd be interested to hear your views of our new services – please email [mark-it@ipo.gov.uk](mailto:mark-it@ipo.gov.uk) if you have any comments.

The logo for 'Right Start' features a blue registered trademark symbol (®) to the left of the word 'Right' in a blue sans-serif font, with the word 'Start' in a lighter blue sans-serif font positioned directly below it.

## International Collaboration

**WHILE WE attempt to structure our fees and services to best meet your needs we also think it is vital that we do what we can to ensure that you get what you need from registries abroad.**

We have long been an active member of the oversight board of OHIM, the Community Trade Mark Office, and have consistently sought to harmonise the trade mark law and practice of EC Member States. The last meeting of the board met on 16-18 November and discussed arrangements for the OHIM's 50m euro Co-operation Fund that will endow projects aimed at improving the experience that users get at OHIM

and the National Offices of Member States. Our work with OHIM on harmonisation took a big leap forward when we signed an agreement to license OHIM's new case handling software system, EuroMarc++, which went into operation earlier this year.

EuroMarc++ was developed at a cost of around €5m to manage the examination, opposition and registration of Community trade marks. OHIM has granted us a royalty-free license for the software, and a range of other support modules, under an agreement whose terms are designed to promote international cooperation and harmonisation of trade mark practices.

We will be able to further develop the software and we will share the results with OHIM, and ultimately other IP offices. Ian Fletcher, our CEO at the time, welcomed the collaboration saying: 'This project is a great example of OHIM and a National Office working together on a harmonisation project that will ultimately benefit business users.'

We also have a number of bilateral technical assistance agreements with individual companies. We are for example working with the Chinese Trade Mark Office to share our experience on a number of issues that are of mutual interest as we both continue to improve our respective registries.

## Other OHIM Harmonisation Project Updates

### TMVIEW

The TMView programme (formerly EuroRegister) aims to create a common trade mark search engine tool to allow users to consult registers of the EU national offices as well as the OHIM's register in one place.

The system will be launched in Brussels this autumn. The UK's data is included in the first phase and all offices should be integrated between 2010 and 2011.

### EUROCLASS

The EuroClass project aims to provide a common online classification tool on which national offices can publish their official and approved list of goods and services, allowing all applicants to share the same single reference point.

This centralised source will provide access to the goods and services offered by all participating European national offices and find equivalents between the expressions for goods and services in the different classification databases.

### EUROACE

The EuroAce Search Engine allows the user to perform searches on descriptions of goods and services and the corresponding class numbers that are acceptable to the OHIM.

It has a very similar look and feel to our internet classification search.

The database also holds classification data in respect of the OHIM bilateral agreement and the trilateral agreement (OHIM/US/ Japan).

These can be searched under each of these agreements. The harmonised database will also be searchable using this tool.

# The dangers of aromatherapy

**THE FOLLOWING is a true report of a business – we plan on including similar case studies (mentioning no company names) in each edition. This should give you an idea of why renewing your trade mark can be so important.**

Two sisters started trading in 1987. One sister was a trained aromatherapist and they traded in her own blended and formulated range of products. The business was successful and a UK wide distribution contract was agreed in 2004. They traded under a very distinctive brand.

Distinctive but not registered.

**Unfortunately they had allowed their trade mark registration to expire.**

The sisters had a cousin who fell on hard times having been declared bankrupt in 1999. He was a mechanic by trade and although he had no personal knowledge or experience in aromatherapy, the two sisters kindly employed him. Initially he helped with general maintenance, but he was subsequently trained and finally held an influential position in the business.

However the cousin, together with his mother and sister, were all the time plotting to start a business of their own. As well as renting similar premises and styling the shop in the same way, they took the entire supplier database and all formulae for the manufacture of products.

Consumers would probably have assumed that they were associated businesses.

Unfortunately the sisters had allowed their trade mark registration to expire. When their cousin became aware of this,

he immediately filed his own application for the same mark and class of goods and services.

The sisters had no option but to oppose the application in order to protect their business operations. Because their trade mark was not registered, they had to prove that

**They had to prove that the application had been made in 'bad faith'.**

the application had been made in 'bad faith'. This was very time consuming in gathering evidence. From the date of application to the final decision, which was in their favour, some 2 years 9 months had elapsed. This was a very long period of uncertainty and effort which could have been much more usefully spent on other business activities. The cousin was ordered to pay £3,200 in costs to the two sisters.

This case study highlights the importance of ensuring that you renew your trade mark. You need to renew on the 10th anniversary of your filing date and every 10 years after that.

There is no limit as to how long you can keep your mark registered.

We will write to remind you 3 months before your renewal is due – please ensure that you keep your contact details with us up to date so that you receive this reminder.

Renewals cost £200 for the first or only class of the registration and £50 for each additional class.

For more details of trade mark renewal see our website at [www.ipo.gov.uk/t-renew.htm](http://www.ipo.gov.uk/t-renew.htm)



# What's on January – May 2010

Date	Event	Location	Contact
JANUARY 12	Intellectual Property Clinics	Newport	<a href="http://www.ipo.gov.uk">www.ipo.gov.uk</a>
FEBRUARY 4	Business Advice Open Day	Ipswich	<a href="http://www.businesslink.gov.uk">www.businesslink.gov.uk</a>
MARCH 16	Intellectual Property Clinics	Newport	<a href="http://www.ipo.gov.uk">www.ipo.gov.uk</a>
MARCH 25	Business Advice Open Day	York	<a href="http://www.businesslink.gov.uk">www.businesslink.gov.uk</a>
APRIL 22	Business Advice Open Day	Edinburgh	<a href="http://www.businesslink.gov.uk">www.businesslink.gov.uk</a>
APRIL 29	Business Advice Open Day	Crawley	<a href="http://www.businesslink.gov.uk">www.businesslink.gov.uk</a>
MAY 6	Business Advice Open Day	Blackpool	<a href="http://www.businesslink.gov.uk">www.businesslink.gov.uk</a>
MAY 18	Intellectual Property Clinics	Newport	<a href="http://www.ipo.gov.uk">www.ipo.gov.uk</a>

## Meet the staff

EVERY MONTH we will introduce key members of our team in Trade Mark Directorate.



### Lynda Adams

BEFORE JOINING the IPO, I worked for the Norwich Union Insurance Company. I joined the IPO more than 20 years ago and began my career in the Patents Directorate. Since moving to Trade marks and Designs Directorate, I have undertaken a number of roles including trade mark examiner, examination team leader, training officer and hearing officer. Currently I am an Operations Manager responsible for the management of around 40 trade mark and designs examiners and I am also a member of the Trade Marks Senior Management Team. Recently I managed the implementation of our new Right Start Application Service which was a challenging but really rewarding experience. I really enjoy my job and am pleased to be part of the Trade Marks Directorate.

### Alan Pike

I JOINED the civil service straight from school as an administrative assistant. Following spells in the Registry of Shipping and Seamen, Insolvency Service and National Statistics I became one of the first Career Guidance Officers in South Wales. I then moved into regional development work at the Welsh Office but later left to take up a managerial appointment in the private sector. I joined the IPO in 1992 as a team leader in the Trade mark and Designs Directorate. I also worked as a hearing officer and must have dealt with over 13,000 hearings before taking up my current role – I am now primarily involved in Quality and Management Information.



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If you have any comments or suggestions regarding this newsletter, you can email them to [mark-it@ipo.gov.uk](mailto:mark-it@ipo.gov.uk)